

REMARKS

With this Amendment, Applicant amends claims 1-2, and 6-7, and adds new claims 11-14. No new matter is added. Therefore, claims 1-14 are all the claims currently pending in the present application.

I. Formal Matters

Applicant respectfully requests that the Examiner acknowledge receipt of the certified copy of the priority document submitted April 9, 2001, and to acknowledge the claim to foreign priority with the next communication in view of the fact that Applicant claimed priority and filed the priority document on April 9, 2001. The USPTO stamped filing receipt dated April 9, 2001 confirms the USPTO's receipt of the certified copy of the priority document, P2000-107037. Applicant is enclosing, for the Examiner's convenience, a copy of the cover sheet of the priority document and a copy of the U.S.P.T.O. stamped filing receipt dated April 9, 2001.

Applicant thanks the Examiner for acknowledging receipt of the Information Disclosure Statements filed March 13, 2003, and April 5, 2004, and for considering the references cited therein.

II. Rejection Under 35 U.S.C. § 103(a) over Dureau in view of Bowcutt & Shimomura

Claims 1-3, 5-8, and 10 are rejected under 35 U.S.C § 103(a) as being allegedly unpatentable over Dureau et al. (U.S. Patent No. 6,118,472; "hereinafter" Dureau) in view of Bowcutt et al. (U.S. Patent No. 6,308,328; hereinafter "Bowcutt") and Shimomura et al. (U.S. Patent No. 6,526,580; hereinafter "Shimomura"). In order to maintain a rejection under § 103(a), the Examiner must establish that "the prior art ... references when combined ... teach or

suggest all the claim limitations.” (See MPEP § 2142). Applicant respectfully submits that the combination of cited references do not disclose, teach, or suggest all of the features of claims 1-3, 5-8, and 10.

Claim 1

Claim 1, requires, *inter alia*:

a method for using the Internet, comprising the steps of:

entering data indicating an operation desired by a user using a telephone and sending the data to a provider's server;

receiving the data, using said provider's server, carrying out the operation desired by the user based on the data.

Applicant respectfully submits that neither Dureau, Bowcutt, Shimomura nor any combination thereof teaches, suggests, or provides the motivation for the above-identified requirement. In contrast to the requirements of claim 1, Dureau is directed to a system for seamless connectivity between the Internet and an interface TV wide-band network. Abstract & Col. 2, lines 27-29. According to the disclosure of Dureau, an end user 14 uses a remote control 55 which provides inputs to decoder 45 in order to select an interactive TV application for output to TV 50. (See Col. 4, lines 22-24 & FIG. 1 of Dureau). “As the decoder 45 receives” inputs from remote control 55 for Internet requests 112, the decoder 45 tunes to a specific channel so that an interactive TV application associated with Internet data 114 can be downloaded from the Internet. Col. 6, lines 9-13. Specifically, Dureau describes that the Internet request 112 received by the decoder 45 is transferred to port 68 of the gateway 70 via communication channel 59.

(See Col. 4, lines 57-59; Col. 6, lines 21-24; and FIGS. 1-2 of Dureau). The gateway 70 receives the Internet request 112 and forwards the Internet request 112 to headend 110 which “executes the native protocols for [Internet] data request 112 and receives Internet data 114 from the Internet 65.” (See Col. 4, lines 65-67 & FIGS. 1-2 of Dureau) (emphasis added).

In rejecting claim 1, the Examiner correctly concedes that Dureau does not teach or suggest the requirement for entering data indicating an operation desired by a user using a telephone and sending the data to a provider’s server, and receiving the data, using said provider’s server, and carrying out the operation desired by the user based on the data, as claimed. (See pg. 3 of the Office Action). However, the Examiner relies on column 7, lines 61-67 and column 8, lines 1-10 of Bowcutt and column 14, lines 40-56 of Shimomura to make up for the deficiencies of Dureau. (See pgs. 3-4 of the Office Action). Particularly, the Examiner suggests that the combination of Dureau, Bowcutt, and Shimomura teaches the above feature of claim 1 because Dureau allegedly teaches the use of a telephone line, such as communication channel 59, to send a request indicating an operation desired by a user that is sent to a server provider 13 and that Bowcutt teaches the use of a cellular phone to provide requests upstream while Shimomura allegedly teaches “sending [a] character data” request. (See *id.*) In view of the above, the Examiner alleges that it would have been obvious for a skilled artisan to modify the system disclosed by “Dureau to include ... a cellular phone ... to provide requests upstream, as taught by Bowcutt” and that it would have been obvious to modify the systems of “Dureau and Bowcutt to make requests by sending character data, as taught by Shimomura.” (See *id.*).

Applicant submits that the proposed combination is deficient and does not teach all of the features of claim 1 for the following reasons.

First, Bowcutt does not make up for the deficiencies of Dureau since Bowcutt does not teach or suggest at least entering data indicating an operation desired by a user using a telephone and sending the data to a provider's server, as claimed. Instead, Bowcutt merely describes that a cable subscriber 175 uses an upstream path to send a request for a cable data service from a "host personal computer or workstation 108" to a cable service provider. (See Col. 9, lines 17-25 & FIG. 1 of Bowcutt). According to the disclosure of Bowcutt, when the cable subscriber 175 initiates the request for cable data service, from the "personal computer 108," the request is passed to a RF modem 106, and the RF modem 106 dials up a telephone modem pool 135 of the service provider via a public switched telephone network (PSTN) 109. Col. 9, lines 26-33. A router 101, responds to the call by RF modem 106, and the router 101 receives the cable data request from the cable subscriber 175 who entered the request "via a keyboard or other data entry means of their personal computer 108" to signify their password. (See Col. 9, lines 37-41) (emphasis added).

The cited portion of Bowcutt merely describes that the upstream path taught by Bowcutt may be "wireless ... by [a] cellular telephone." (See Col. 8, lines 3-5). As such, Bowcutt, merely suggests that a cellular telephone may be used as a RF modem 106 and that the PSTN 109 is used to connect a call from the cellular telephone to the telephone modem pool 135 so that the cable subscriber's 175 cable data request can be transmitted to telephone modem pool 135.

As demonstrated above, Bowcutt merely describes that cable subscriber 175 enters a cable data request via a keyboard of their personal computer or workstation 108 and that the request is transmitted upstream to a service provider. Accordingly, Bowcutt does not teach and is incapable of suggesting entering data indicating an operation desired by a user using a telephone and sending the data to a provider's server, as claimed. Applicant therefore submits that the combination of the cited references do not teach, or suggest all of the features of claim 1 for at least the reasons discussed above.

Second, assuming *arguendo* that the Examiner is suggesting that the remote control 55 and the decoder 45 of Dureau may be replaced with the cellular telephone phone of Bowcutt, Applicant submits that there is *no reasonable expectation* that the references may be *successfully* modified in this manner. (See MPEP § 2143.02). As previously noted, Dureau teaches that end user 14 uses a remote control 55 to provide inputs to decoder 45 in order to request Internet data 112 corresponding to an interactive TV application. Col. 4, lines 22-24. The Internet data request 112 received by the decoder 45 is sent to gateway 70 which retrieves Internet data 114. The decoder 45 also receives encoded Internet data 114 via download signal 37 sent from satellite dish 40, and the decoder 45 decodes the Internet data 114 and outputs the decoded Internet data 114 to TV 50 for display. Col. 4, lines 17-21; Col. 5, lines 10-12; FIG. 1 of Dureau. There is no disclosure or teaching in Bowcutt suggesting that the cellular telephone taught therein is capable of receiving and decoding Internet data and there is no suggestion that the cellular telephone is capable of outputting decoded Internet data to a TV for display. Applicant

therefore submits that the Examiner's proposed combination of Dureau and Bowcutt is deficient and does not teach or suggest all of the features of claim 1 for this additional reason.

Third, Applicant submits that Shimomura does not make up for the deficient teachings of Dureau and Bowcutt and that the combination of Dureau along with Bowcutt and Shimomura does not teach or suggest all of the features of claim 1. To be precise, Shimomura fails to teach, or suggest at least entering data indicating an operation desired by a user using a telephone and sending the data to a provider's server, as required by claim 1. In contrast to the requirements of claim 1, Shimomura is directed to a data broadcast system wherein a data broadcast control center 150 receives digital information streams from a number of different data origination sources 110, 113, and 115. (*See* Col. 3, lines 52-54 & FIG. 1 of Shimomura). The data broadcast control center 150 multiplexes the received digital information streams into a digital broadcast signal and transmits the digital broadcast signal on a broadcast distribution medium to a wireless multimedia receiver/server device 330. (*See* Col. 4, lines 4-15; FIGS. 1 & 3a - 3d). The wireless multimedia receiver/server device 330 demodulates the digital broadcast signal to retrieve the multiplexed digital information streams and extracts a subset of digital information streams requested by the owner (or user) of the wireless multimedia receiver/server device 330. Abstract & Col. 4, lines 25-27. The multimedia receiver/server device 330 outputs the digital information streams to a client system such as a personal computer 310 or a television set top box 320 so that the digital information stream can be displayed. Col. 6, lines 11-17. The cited portion of Shimomura merely describes that the wireless multimedia receiver/server device 330 may contain "wireless network circuitry 543 for providing a wireless back channel" so that a

user can access the Internet via their wireless multimedia receiver/server device 330 and perform ecommerce transactions by subscribing to the Short Messaging Service (SMS) of a service provider. Col. 14, lines 40-56.

Even assuming *arguendo* that Shimomura discloses that the SMS allows a user of the wireless multimedia receiver/server device 330 to access the Internet by “[sending] requests, as text messages,” as contended by the Examiner, the combination of Dureau, Bowcutt and Shimomura does not teach or suggest all of the features of claim 1. At best, Shimomura discloses sending requests as text messages from a wireless multimedia receiver/server device 330 to a service provider. Given that Bowcutt teaches that a cable subscriber 175 sends a cable data request via a keyboard of a personal computer 108 and since Shimomura allegedly teaches that a user sends a request as a text message from a wireless multimedia receiver/server device 330, the Examiner has not demonstrated how the combination of Dureau, Bowcutt, and Shimomura teaches or provides the motivation for entering data indicating an operation desired by a user using a telephone and sending the data to a provider’s server and receiving the data, using said provider’s server, carrying out the operation desired by the user based on the data, as claimed. Applicant respectfully submits that the combination of cited references do not teach or suggest all of the features of claim 1 for this additional reason.

Since neither Dureau, Bowcutt, Shimomura nor any combination thereof teaches all of the features of claim 1, as discussed above, the cited references cannot be said to render the subject matter of claim 1 obvious within the meaning of 35 U.S.C. § 103. Applicant therefore

respectfully requests the Examiner to reconsider and withdraw the rejection of claim 1 and its dependent claims 2-5.

Claims 2 & 7

With further regard to claim 2, Applicant respectfully submits that claim 2 is independently patentable given that the cited combination of references do not teach, suggest, or provide the motivation for the claim limitation wherein the data are entered and sent by the user using an Internet mail function of the said telephone, as required by claim 2. In rejecting claim 2, the Examiner alleges that the combination of Dureau, Bowcutt, and Shimomura teaches the above features of claim 2 because column 14, lines 40-56 of Shimomura allegedly discloses that “the SMS messages are mail messages being sent to an Internet server.” (See pg. 4 of the Office Action). Contrary to the assertion of the Examiner, neither Dureau, Bowcutt, Shimomura nor any combination thereof teaches the features of claim 2.

Even assuming *arguendo* that Shimomura teaches that SMS messages are mail messages sent to an Internet server, as contended by the Examiner, the cited portion of Shimomura does not teach the features of claim 2. At best, Shimomura discloses sending text messages from a **wireless multimedia receiver/server device 330**. (See Col. 6, lines 18-20; Col. 14, lines 40-56 & FIGS. 3a-3b of Shimomura). As discussed above, Bowcutt merely describes that a cable subscriber 175 enters a cable data request via a keyboard of their **personal computer or workstation 108** and that the request is transmitted to a service provider. Nowhere in the cited references is there any disclosure or teaching suggesting an Internet mail function of a telephone, as claimed. Accordingly, Dureau, Bowcutt, and Shimomura do not disclose, teach or suggest the

requirement for wherein the data are entered and sent by the user using an Internet mail function of said telephone, as recited in claim 2.

Since claim 7 contains features that are similar to the features recited in claim 2, Applicant respectfully submits that claim 7 is independently patentable for reasons analogous to those submitted for claim 2. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of claims 2 and 7 for this additional reason.

Claim 6

Given that claim 6 contains features that are similar to the features recited in claim 1, Applicant respectfully submits that claim 6 is patentable for reasons analogous to those submitted for claim 1. To be precise, the cited combination of references fails to disclose, teach or suggest at least an internet usage system, comprising, *inter alia*, a telephone which is used to enter data indicating an operation desired by a user and to send the data to a provider's server, and said provider's server which receives the data from said telephone to carry out the operation desired by the user based on the data, as claimed.

Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of claim 6 and its dependent claims 7-10.

IV. Rejection under 35 U.S.C. § 103(a) over Dureau, Bowcutt, & Shimomura in view of Majeti

Claims 4 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dureau, Bowcutt, and Shimomura, and further in view of Majeti et al. (U.S. Patent No. 5,534,913; hereinafter "Majeti"). Applicant submits that claims 4 and 9 are patentable for at least the reasons submitted for independent claims 1 and 6 and because Majeti fails to make up

for the deficiencies of Dureau, Bowcutt, and Shimomuru. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of claims 4 and 9.

V. New Claims

Applicant has added new claims 11-14 in order to more fully cover various aspects of Applicant's invention as disclosed in the specification. In addition to their dependencies from claims 1 and 6, Applicant respectfully submits that claims 11-14 should be allowable because the cited prior art does not teach or suggest the limitations of these claims.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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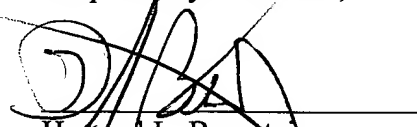
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